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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,449	09/27/2000	NOBUO MATSUI	0107-128	6013

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EXAMINER

VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/671,449

Applicant(s)

MATSUI, NOBUO

Examiner

John M. Villecco

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive.
2. Applicant has amended independent claim 1 (thus modifying the scope of the claim) to more clearly identify the structure of the invention by providing more detail to the description of the support member and how each of the parts are positioned. Applicant asserts that this amendment overcomes the prior art. However, the examiner disagrees with the applicant's conclusion and still believes that the Shimamura reference (U.S. Patent No. 5,721,586) can still be read on the claimed invention. Please see the rejection below for a description of how the claims are rejected based on Shimamura.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 2 recites the limitation "the overlapping mechanism" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. Applicant has amended claim 1, taking the limitation of an "overlapping mechanism" out of the claim, thus creating the

Art Unit: 2612

antecedent basis problem. For examination purposes it will be assumed that applicant means that the prompter support member includes a slide mechanism.

6. Claim 3 and 4 are rejected based upon their dependency to claim 2.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by**

Shimamura et al. (U.S. Patent No. 5,721,586).

9. Regarding *claim 1*, Shimamura discloses a prompter support system which includes a display unit (22), a semitransparent mirror (35) which reflects the light from the display in a predetermined direction, and a TV camera (10). The support member includes swing arm (16B) and slideable arm (16C) which act as the plurality of support members. The prompter is comprised of a multi-divisional structure having a plurality of support members. The first support stage is interpreted to be the holder frame (20). The second support stage is interpreted to be the support plate (34). As shown in Figure 5, the holder frame (20), support plate (34) display unit (22), and mirror (35) are positioned such that they overlap each other.

10. As for *claim 2*, Shimamura discloses that the arm (16C), to which the holder frame is connected, is slideable using the fixing screw (19C). The arms 16B and 16C are slid in an overlapping manner (which includes moving the support members closer to each other) in order

Art Unit: 2612

to be adjusted to the users requirements. Each of the holder frame (20) and the support plate (34) is connected to the slide mechanism, albeit indirectly. Each of the arms (16A, 16B, 16C) are interpreted to be part of the plurality of support members. As the slide mechanism is slid towards the left (in Figure 5) the plurality of support members are slid closer to each other so as to overlap the support members.

11. With regard to *claim 3*, the examiner interprets the holder (20) and arms (16A, 16B, 16C) to form the second support member, and the support plate (34) to be the first support member.

12. Regarding *claim 11*, as shown in Figure 5, the holder frame (20) and arms (16A, 16B, and 16C) are slid to overlap the top face of the support plate (34) and the mirror (35) is folded up onto the second support stage.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimamura et al. (U.S. Patent No. 5,721,586) in view of Wasada (Japanese Publ. No. 11-101931 A).**

15. Regarding claim 4, as mentioned above in the discussion of claim 3, Shimamura discloses all of the limitations of the parent claim. Additionally, Shimamura discloses that the display unit (22) and the mirror (35) are supported by the first support member. However, Shimamura discloses that the camera is supporting the second support member, since the support

Art Unit: 2612

structure is mounted on the top of the camera. Wasada, on the other hand, discloses that it is well known in the art to mount a support structure for a prompter on the bottom of the camera. More specifically, Wasada discloses that the support member (26) is mounted on the bottom of the camera (18). If the structure of Wasada were implemented in the camera of Shimamura the second support member would be supporting the camera. This arrangement allows for easier and quicker adjustment of the prompter since it is located at a lower level. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange the support structure of Shimamura on the bottom of the camera, instead of the top.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

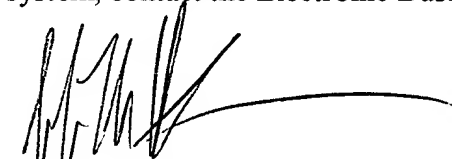
Art Unit: 2612

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460.

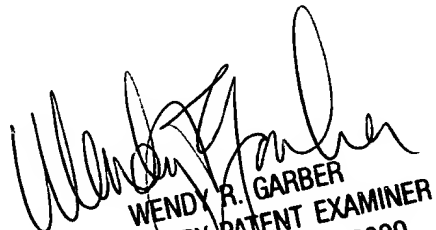
The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco
January 27, 2005



WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
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